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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,803	12/15/2003	John L. Baier	58010/41912	4156

7590 07/26/2006

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EXAMINER	
STASHICK, ANTHONY D	

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/736,803	BAIER ET AL.	
	Examiner	Art Unit	
	Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim 5,617,650. Grim '650 discloses all the limitations of the claims including the following: a midsole 92 having a midsole bottom surface (facing the bladder 82), a midsole top surface (facing user's foot), and midsole medial and lateral side surfaces extending up from the midsole bottom surface (connecting the top and bottom surfaces); an outsole 83 having an outsole forefoot portion and an outsole heel portion (see Figure 9), the outsole forefoot portion being adjacent the midsole bottom surface (see Figure 9), the outsole heel portion being adjacent the midsole bottom surface (see Figure 9); an upper 84 having an upper heel portion (located over 88 in Figure 7), an upper medial portion (see Figure 7) and an upper lateral portion (also Figure 7), the upper heel portion being laterally between the upper medial portion and the upper lateral portion, the upper extending up from the midsole (see Figure 7); a closure system having a medial closure portion operatively connected to the upper medial portion and a lateral closure portion operatively connected to the upper lateral portion (see Figures 7-9, front portion of upper as well as that with holes in sections 89 and 88) the closure system being adapted for movement between a tensioned condition and a loosened condition (when lace is tightened or loosened), the tensioned condition being a condition in which the closure system maintains the medial closure portion a tightened distance from the lateral closure portion (normal use of a shoe when tied), the loosened condition being a condition in which the closure system maintains the medial closure portion a loosened distance from the lateral closure portion (normal use of a shoe when untied and off the user's foot), the loosened distance being greater than the

tightened distance (typical for a tying shoe); a sole stiffening member 82 having a connecting portion (in front of heel and behind the forefoot), a forefoot engageable portion (located as part of the area between 86 and 87) extending generally forward from the connecting portion, a heel engageable portion (located as part of the area between 88 and 89) extending generally rearward from the connecting portion (see Figure 8), a medial wing portion extending generally medially from the connecting portion (assuming right foot for Figure 8, this would be portion 88), and a lateral wing portion extending generally laterally from the connecting portion (assuming right foot for Figure 8, this would be portion 89), the forefoot engageable portion secured to the outsole forefoot portion (see Figure 9), the heel engageable portion secured to the outsole heel portion (see Figure 9), the medial wing portion having a medial distal tip portion (that of 88 just behind hole in it in Figure 8), the lateral wing portion having a lateral distal tip portion (that of 89 just behind hole in it in Figure 8), the medial and lateral wing portions being positioned such that at least a portion of a straight line segment extending from the medial distal tip portion to the lateral distal tip portion is spaced over at least a portion of the midsole top surface (see Figure 9), the portion of the midsole top surface being between the portion of the line segment and a portion of the midsole bottom surface (see Figure 9), the sole stiffening member being adapted to provide increased support in a shank area of the shoe (portion 82 located in the shank area of the shoe); a securing system having a heel securing portion located adjacent the upper heel portion (see Figure 7), a medial instep securing portion extending generally forward from the heel securing portion and being operatively connected to the medial closure portion (see Figure 7), a lateral instep securing portion extending generally forward from the heel securing portion and being operatively connected to the lateral closure portion (see Figure 7), a medial attaching portion extending generally downward from the heel securing portion and the medial instep securing portion (see Figures 7 and 8), and a lateral attaching portion extending generally downward from the heel securing portion and the lateral instep securing portion (see Figures 7 and 8), the medial attaching portion being operatively connected to the medial wing portion of

the sole stiffening member (portion 88 with hole in it in Figure 8), the lateral attaching portion being operatively connected to the lateral wing portion of the sole stiffening member (portion 89 with hole in it in Figure 8), the securing system being adapted to interact with the closure system such that placing the closure system in the tensioned condition creates securing forces directed toward a wearer's foot from the securing system and the sole stiffening member (see Figure 7, interacts with closing system shoe string through hole in 88 and 89); placing the closure system in the tensioned condition moves a portion of the outsole and a portion of the upper heel portion toward a wearer's foot (typical in tightening of a shoe upper); placing the closure system in the tensioned condition compresses a portion of the shoe between a wearer's foot and the sole stiffening member and the securing system (pulls up on portion 82); placing the closure system in the tensioned condition places the sole stiffening member and the securing system in tension (pulls up on both); the securing system and the sole stiffening member are a single unitary piece (holes in 88 and 89 which are part of 82 as seen in Figure 8); the forefoot engageable portion of the sole stiffening member is between the midsole bottom surface and the outsole forefoot portion (see Figure 7), and the heel engageable portion of the sole stiffening member is between the midsole bottom surface and the outsole heel portion (see Figure 7); the sole stiffening member has a sole stiffening member hardness (bladder hardness) and the securing system has a securing system hardness (flexibility of the lace), the sole stiffening member hardness being greater than the securing system hardness (bladder less flexible than the lace); the forefoot engageable portion of the sole stiffening member includes a medial tab 86 and a lateral tab 87, the medial tab extending from the connecting portion toward the midsole medial side surface (see Figure 8), the lateral tab extending from the connecting portion toward the midsole lateral side surface (see Figure 8); the sole stiffening member provides increased support in the shank area of the shoe in a vertical direction (responds to vertical forces applied to foot during shoe contact with the ground surface); the sole stiffening member is adapted to translate forces from a heel region of the shoe to a forefoot region of the shoe as the heel region of the shoe strikes the ground (air in bladder moves as user

moves throughout the gait cycle from the heel to the toe); the sole stiffening member is adapted to interact with the midsole such that a portion of the midsole bottom surface adjacent the sole stiffening member is compressed as the shoe bends during use (compression of shoe midsole of upper occurs when the shoe is bent); the sole stiffening member has a sole stiffening member hardness (hardness of the bladder) and the upper has an upper hardness (hardness of the upper), the sole stiffening member hardness being greater than the upper hardness (how portions 86, 87, 88 and 89 give support to upper); an upper 84 extending up from the midsole; the midsole bottom surface contacts the outsole forefoot portion and the outsole heel portion (see Figures 6 and 7, in figure 6, the outsole is 74, 14 and the layer above 14, a "layered" outsole).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand et al. 5,894,684. Sand et al. '684 discloses all the limitations substantially as claimed including the following: a midsole 12/62 having a midsole bottom surface (that facing the outsole), a midsole top surface (that facing the user's foot), and midsole medial and lateral side surfaces extending up from the midsole bottom surface (connecting the bottom and top surfaces); an outsole 66 having an outsole forefoot portion and an outsole heel portion (see Figure 18), the outsole forefoot portion being adjacent the midsole bottom surface (see Figure 18), the outsole heel portion being adjacent the midsole bottom surface (see Figure 18); an upper 68 having an upper heel portion, an upper medial portion and an upper lateral portion (see Figure 18, liner 68), the upper heel portion being laterally between the upper medial portion and the upper lateral portion (see Figure 18), the upper extending up from the midsole (see Figure 18); a closure system (shown in

Figures 18 and 19) having a medial closure portion operatively connected to the upper medial portion and a lateral closure portion operatively connected to the upper lateral portion (see Figure 19), the closure system being adapted for movement between a tensioned condition and a loosened condition (normal tightening and loosening of the laces), the tensioned condition being a condition in which the closure system maintains the medial closure portion a tightened distance from the lateral closure portion (typical for a tied shoe), the loosened condition being a condition in which the closure system maintains the medial closure portion a loosened distance from the lateral closure portion (typical for an untied shoe), the loosened distance being greater than the tightened distance (typical for tied shoes); a sole stiffening member 12/62 having a connecting portion (located in arch area), a forefoot engageable portion (located under the user's forefoot as shown in Figure 7) extending generally forward from the connecting portion, a heel engageable portion (located under the heel of the user) extending generally rearward from the connecting portion, a medial wing portion (side portion in Figure 18) extending generally medially from the connecting portion, and a lateral wing portion (opposite medial portion in Figure 18) extending generally laterally from the connecting portion, the forefoot engageable (shown in Figure 7) portion secured to the outsole forefoot portion, the heel engageable portion (Figure 18) secured to the outsole heel portion, the medial wing portion having a medial distal tip portion (see Figure 18), the lateral wing portion having a lateral distal tip portion (see Figure 18), the medial and lateral wing portions being positioned such that at least a portion of a straight line segment extending from the medial distal tip portion to the lateral distal tip portion is spaced over at least a portion of the midsole top surface (see Figure 18), the portion of the midsole top surface being between the portion of the line segment and a portion of the midsole bottom surface (see Figure 18), the sole stiffening member being adapted to provide increased support in a shank area of the shoe (stiffening member located in shank of shoe, also located in entire shoe length); a securing system 26/76 having a heel securing portion located adjacent the upper heel portion (see Figures 7 and 18), a medial instep securing portion 18/78 extending generally

forward from the heel securing portion and being operatively connected to the medial closure portion (see Figure 18), a lateral instep securing portion (also 18/78 on opposite side of shoe sole) extending generally forward from the heel securing portion and being operatively connected to the lateral closure portion (see Figure 18), a medial attaching portion (located between the forefoot and heel portions) extending generally downward from the heel securing portion (see Figure 18) and the medial instep securing portion (see Figure 18), and a lateral attaching portion (see Figure 18) extending generally downward from the heel securing portion and the lateral instep securing portion (also Figure 18), the medial attaching portion being operatively connected to the medial wing portion of the sole stiffening member (see 18 in Figure 18), the lateral attaching portion being operatively connected to the lateral wing portion of the sole stiffening member (see other 18 in Figure 18), the securing system being adapted to interact with the closure system such that placing the closure system in the tensioned condition creates securing forces directed toward a wearer's foot from the securing system and the sole stiffening member (see Figure 18 how the straps interact with the shoe closure system); placing the closure system in the tensioned condition moves a portion of the outsole and a portion of the upper heel portion toward a wearer's foot (tightening of the shoe); placing the closure system in the tensioned condition compresses a portion of the shoe between a wearer's foot and the sole stiffening member and the securing system (this portion will compress when tightening the shoe on the user's foot); placing the closure system in the tensioned condition places the sole stiffening member and the securing system in tension (fastening of shoe as shown in Figure 19); the securing system and the sole stiffening member are a single unitary piece (see Figures 7 and 18); the forefoot engageable portion of the sole stiffening member is between the midsole bottom surface and the outsole forefoot portion (Figure 18 with the forefoot portion of figure 7 adapted thereto), and the heel engageable portion of the sole stiffening member is between the midsole bottom surface and the outsole heel portion (see Figure 18 in the heel section); the sole stiffening member has a sole stiffening member hardness (supports the user's foot) and the securing system has a securing system

hardness (flexible straps), the sole stiffening member hardness being greater than the securing system hardness (more rigid support of sole as compared to flexible strapping system); the sole stiffening member provides increased support in the shank area of the shoe in a vertical direction (stiffening member located in the shank of the shoe); the sole stiffening member is adapted to translate forces from a heel region of the shoe to a forefoot region of the shoe as the heel region of the shoe strikes the ground (does so through the gait of the user as the user travels from the heel to the toe); the sole stiffening member is adapted to interact with the midsole such that a portion of the midsole bottom surface adjacent the sole stiffening member is compressed as the shoe bends during use (compresses layer 92 in Figure 18 when going from the heel to the toe during use); the sole stiffening member has a sole stiffening member hardness more rigid for support of the user's foot) and the upper has an upper hardness (softer and flexible), the sole stiffening member hardness being greater than the upper hardness (the more rigid support of the stiffener versus the flexibility of the upper); an upper (see Figure 18) extending up from the midsole. Although Sand et al. '684 does not teach all the limitations in a single embodiment, it would have been well within the skill of one of ordinary skill in the art to use the teachings of the embodiment of Figure 7 in the embodiment of Figures 18 and 19 to aid in better supporting the entire sole of the user's foot in the shoe; the midsole bottom surface contacts the outsole forefoot portion and the outsole heel portion (see Figures 7 and 18-19).

Response to Arguments

5. Applicant's arguments filed May 11, 2006 have been fully considered but they are not persuasive. Applicant argues that in both Grim and Sand, the midsole is not adjacent the outsole, i.e. not immediately next to or touching. This appears to be more than that which applicant is claiming. The claim only requires the sole to be "adjacent" one another. Giving the claim it's broadest reasonable interpretation with respect to the term "adjacent", the term adjacent has been determined to mean "nearby, not distant,

in close proximity to". Therefore, since the midsole and outsole of both Grim and Sand meet these definitions of "adjacent", they therefore "read on' the claimed invention as noted in the rejections set forth above. Applicant further argues that grim does not show function of the holes in Figure 8, but clearly the function of the hole can be seen in Figure 7. If the connection portion to the holes as shown is a valve or tube, these holes are still attached to the opening in the shoe that is closed by the closure system of the shoe and therefore they "interact" with the closure system, meeting the claimed limitations.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

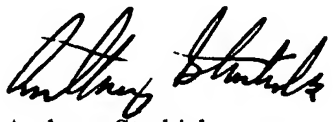
7. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the

replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS